



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,338	03/04/2002	Basil Naji	BALDS2.032AUS	3937
20995	7590	03/09/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,338

Applicant(s)

NAJI ET AL.

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1755

35 USC 102/103 Rejection:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Duselis et al. 146 B1, Styron '137 or '258 B2, Styron '632 B2, Brothers et al. '921 B1, Brook et al. '458 or '310, Onan et al. '521, Smetana et al. '255, Wills Jr '316, Minnick '408, Barbour '595 B1, Francis et al. '518, Comrie '668, Moreau et al. '275, KR 2000014685 (Na et al.-abstract only), CN 1160070 (Wan-abstract only), DE 19607081 (Ecker-abstract only), or JP 07187734 (Nakano et al.-abstract only).

Duselis et al. teach a composition comprising a cement material such as Portland cement, fly ash, rice hull ash (also aluminous), and 0 to 40 wt% alumina trihydrate (see claim 62) anticipating the instant invention.

Art Unit: 1755

Styron '258 B2 teaches a composition comprising Portland cement (aluminous) and fly ash thus anticipating the instant invention (see claims).

Styron '137 teaches a composition comprising fly ash, cement, and alumina thus anticipating the instant invention (see claims).

Styron '632 B2 teaches a composition comprising fly ash and gypsum thus anticipating the instant invention. The applicants' use of comprising allows for the inclusion of other components such as gypsum.

Brothers et al. '921 teach a composition comprising fly ash and calcium aluminate (an aluminous material) thus anticipating the instant invention.

Brook et al. '458 or '310 both teach a composition comprising Portland cement and an aluminous material (see claims).

Onan et al. teach a composition comprising cement (aluminous), fly ash, and water thus anticipating the instant invention. Onan teaches his fly ash particle size range can be no larger than about 10 microns (col.4, line 19).

Smetana et al. teach a composition comprising Portland cement, fly ash, and water thus anticipating the instant invention (see claims).

Wills Jr. '316 teaches a composition comprising Portland cement (aluminous), kiln dust (aluminous), and fly ash (aluminous) thus anticipating the instant invention.

Minnick '408 teaches a composition comprising fly ash and Portland cement thus Anticipating the instant invention.

Barbour '595 B1 teaches a composition comprising cement (aluminous) and fly ash thus anticipating the instant invention (see claims).

Art Unit: 1755

Francis et al. '518 teach a composition comprising fly ash and gypsum and other components thus anticipating the instant invention. Note the inclusion of other components is permissible because applicants use comprising claim language.

Comrie '668 teaches a composition comprising fly ash and aluminum oxide (alumina) thus anticipating the instant invention (see claim 1).

Moreau et al. '275 teach a composition comprising hydraulic cement and fly ash thus anticipating the instant invention.

Na et al.(KR '685) teach a composition comprising cement (aluminous), fly ash (aluminous), and alumina thus anticipating the instant invention.

Wan (CN '070) teaches a composition comprising fly ash and alumina thus anticipating the instant invention.

Ecker (DE '081) teaches a composition comprising fly ash and aluminum hydroxide (hydrated alumina) thus anticipating the instant invention.

Nakano et al. (JP '734) teach a composition comprising aluminous cement (aluminous material) and fly ash thus anticipating the instant invention.

For the references above, even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. Further, the prior art teaches particle size ranges that overlap the instant invention. For those that do not, control of particle size would have been a parameter within the control of one of ordinary skill in the art. More so, applicants have not shown criticality or unexpected results with respect to their claimed particle size range.

Art Unit: 1755

Obviousness-type Double Patenting Rejection:

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-78 of U.S. Patent No. 6,346,B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach compositions comprising fly ash and other components such as 0-40 wt% alumina trihydrate (see col.19, claim 62).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 112 Second Paragraph:

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 1 is indefinite because applicants do not particularly point out and distinctly claim the specific amounts of each component of their additive.

The term "predominant particle size" is not clear throughout the claims (e.g. claim 1). Do applicants mean "at least 50% of the particles are in this range" in accordance

Art Unit: 1755

with In re Thomas, 178 F 2d 412, 84 USPQ 132 (CCPA 1949). Clarification of this term is respectfully requested.

The terms "fly ash" and "aluminous material" are not patentably distinguishable components. Fly ash is an aluminous material and thus claim 1 is indefinite (as are its dependent claims) because fly ash contains an alumina component and also is an aluminous material. Applicants can resolve this problem by inserting the limitations of claim 4 into claim 1.

It is noted that the applicants composition breakdown of fly ash reads upon either class C or class F fly ash (see claim 2).

Claim 7 is improper and indefinite because it refers to the preamble limitation (the slurry) when there is no slurry that is actually part of the claim. Applicants are not claiming an additive in a slurry but only the additive. There is also no period at the end of the claim.

Claim 8 is indefinite for the same reason as claim 7. Also, there is no cement in the composition of claim 1. The preamble is not a claim limitation and cement and water are not components of the claimed additive.

Claim 9 is indefinite again for the same reasons as claims 7 and 8.

Claim 9 is further indefinite because applicants do not particularly point out and distinctly claim their fillers. Further, how does their filler differ from fly ash or the other aluminous component of claim 1 which can also be fillers?

Claim 12 is indefinite because fly ash is an aluminous material.

Art Unit: 1755

The term "conventional" plasticizer is indefinite in claim 7 and throughout the claims. Deletion of "conventional" is advised.

Objection to the Specification:

The last paragraph of the specification is objected to because while the applicants can be their own lexicographer, it is improper to provide a definition to a term conventionally known in the art (ie aluminous material) and limit it to hydrated and unhydrated alumina. Aluminous material includes any material that has an aluminous component including Portland cement and fly ash. Applicant cannot simply say that the term "aluminous material" cannot be taken literally. That is not true because it most certainly can be taken literally in the claims. Terms cannot be used when given meanings which are repugnant to their usual meanings. In *re Hill*, 73 USPQ 482 (CCPA 1947). It also can read upon any number of aluminous materials. More so, it is improper for applicants to read these limitations into the claims. If applicants mean those specific aluminous materials, then they should actually place those specific aluminous materials into their independent claims (ie claim 1). While it is true that the claims may be read in light of the specification, it is improper to read the limitations of the specification into the claims. In *re Yamato*, 222 USPQ 93; In *re Wilson*, 149 USPQ 523; *Graver Tank v. Linde Air Products Co.* 80 USPQ 451 (Supreme Court).

Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755